UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Sean D. Solberg
DORSEY & WHITNEY LLP
Intellectual Property Department
Suite 1500, 50 South Sixth Street
Minneapolis, MN 55402-1498

COPY MAILED

OCT 0 8 2004

OFFICE OF PETITIONS

In re Application of

Daniel T. Johnson, et al. Application No. 10/734,725

Filed: December 12, 2003 Attorney Docket No. 14573.01

led: December 12, 2003

: DECISION ON PETITION

: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition filed on July 21, 2004, which is being treated under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is applicable to applications filed on or after November 29, 2000 and is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Further, a petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

Petitioner failed to submit an Application Data Sheet or an amendment to the first sentence of the specification following the title to include a proper reference to the prior-filed application. It is noted that the present petition states that "[a] pplicant submits herewith a Request to Amend the

Specification to incorporate the priority claim." However, no such amendment was found among the papers filed July 21, 2004.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and a substitute amendment¹ stating the relationship of the prior-filed application to the instant application is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITION

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

U.S. Patent and Trademark Office

220 20th Street S.

Customer Window, Mail Stop PETITION Crystal Plaza Two, Lobby, Room 1B03

Arlington, VA 22202

The centralized facsimile number is (703) 872-9306.

Telephone inquiries related to this decision should be directed to Sherry D. Brinkley at (571) 272-3204.

Sherry D. Brinkley Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner for Patent Examination Policy

Karen O. Creasy
Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner for Patent Examination Policy

¹ Note 37 CFR 1.121